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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,212	03/06/2002	Christian Wamprecht	Mo-6799/LeA 34,847	8591

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BAYER CORPORATION
PATENT DEPARTMENT
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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,212

Applicant(s)

WAMPRECHT ET AL

Examiner

Patrick D. Niland

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1714

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4079028 Emmons et al..

Emmons discloses a polyurethane thickener which is the reaction product of diisocyanate, polyether polyol having 3 or more OH groups, monoalcohol and monoamine. Upon reaction with the isocyanate, the polyetherpolyol will have 4 or more OH groups where it began with 3 OH groups and will possess urethane groups. It is not possible to distinguish this portion of the reaction product of the instant claims and the prior art based on the ingredients which initially formed the polyurethane segment. In other words, making the polyurethane thickener from only the instantly claimed polyether a1 will necessarily give moieties falling within the scope of both a1 and a2 upon reaction with diisocyanate. It is also expected that the patentee's reaction of diisocyanate with the polyether polyol will give a mixture falling within the scope of the instant claim 8, step A. Emmons discloses the combination of monols and amines at column 9, lines 46-68 and column 10, lines 1-19. The degree of picking and choosing required to arrive at the instantly claimed invention is sufficient to remove this reference from the scope of an anticipating reference under the relevant caselaw, such as but not limited to *In re Baird*. See column 2, lines

Art Unit: 1714

59-68; column 3, lines 1-68, particularly 31-61; column 4, lines 1-5; column 6, lines 1-68; column 8, lines 1-23 and 48-68; column 9, lines 46-68; and the remainder of the document, particularly the examples. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combination of ingredients to form the thickener of the patentee because the patentee clearly encompasses such mixtures of reactants and the instantly claimed combination of ingredients would have been expected to give the thickening properties discussed by the patentee.

4. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/30425 Martz et al..

Martz discloses the instantly claimed thickeners at the abstract; page 3, lines 22-30; page 4, lines 1-30, particularly 14-16 and 24-29; page 5, lines 1-30, particularly 11-17 and 20-26 and the remainder of the document. Upon reaction with the isocyanate, the polyetherpolyol will have 4 or more OH groups where it began with 3 OH groups and will possess urethane groups. It is not possible to distinguish this portion of the reaction product of the instant claims and the prior art based on the ingredients which initially formed the polyurethane segment. In other words, making the polyurethane thickener from only the instantly claimed polyether a1 will necessarily give moieties falling within the scope of both a1 and a2 upon reaction with diisocyanate. It is also expected that the patentee's reaction of diisocyanate with the polyether polyol will give a mixture falling within the scope of the instant claim 8, step A. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combination

Art Unit: 1714

of ingredients to form the thickener of Martz because the patentee clearly encompasses such mixtures of reactants and the instantly claimed combination of ingredients would have been expected to give the thickening properties discussed by Martz.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/091960 and claims 1-12 of copending application serial number 10/092077. Although the conflicting claims are not identical, they are not patentably distinct from each other

Art Unit: 1714

because, although the claims differ somewhat in scope, they overlap such that it would have been obvious to the ordinary skilled artisan at the time of the instant invention to perform the instantly claimed invention from the claims of the copending application because most of the copending claims' invention is that of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (703) 308-3510. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

Septmeber 16, 2002



Patrick Niland
Primary Examiner
Art Unit 1714